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REMARKS

The claims have been amended by rewriting claim 3 and 5, cancelling claims 1 and 2, and submitting new claims 36 through 38. Claims 3, 4, 5 and 6-38 remain in the application.

Applicants respectfully request that the rejection of the claims presented be reconsidered and withdrawn in light of the amendments above and the discussion which follows and that the application be found in condition for immediate allowance.

Abstract Abridged

Although not objected to by the Examiner, Applicants have redacted the abstract to conform to Office length requirements.

Claim Rejections

The 35 USC §102 Rejections

Claim 5

It is Applicants' understanding that a rejection on the basis of anticipation under 35 USC 102 is appropriate where each element of a claim at issue is found in a single prior art reference. See Kalman v Kimberly-Clark Corp., 218 USPQ 781 at 789, (Fed. Cir. 1983). The requirement is for an element by element comparison of the recited structure, function and operative steps with what is found in the reference sought to be applied. The rejection is proper where such an element by element comparison finds identity for each element within the four corners of the reference.

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It is respectfully submitted that the rejection made in the Official Action falls short of this standard. Further, it is respectfully submitted that no rejection can be framed on the basis of the references cited, whether applied or not, which will support a refusal to allow the claims as presented, without regard for whether that possible rejection is grounded on anticipation under 35 USC 102 or obviousness under 35 USC 103.

Turning first to Claim 5, that claim stands rejected as anticipated by the disclosure of Reifman et al., United States Patent 5,438,433 (Hereinafter "Reifman").

Claim 5 has been rewritten in independent form. For the record, although indicated as "currently amended," claim 5 is of original scope and thus has not been amended for any reason related to the statutory requirements for obtaining a patent. Therefore this claim is not subject to the prosecution history estoppel imposed by Festo. See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 122 S. Ct. 1931, 1840, 62 U.S.P.Q.2d 1705, 1712 (2002).

Applicants respectfully submit that the rejection to claim 5 based on the Reifman reference is traversed for the reasons set forth below.

Applicants submit that Reifman actually fails to disclose, or suggest, at least the following bold highlighted portions of Claim 5:

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5. A multifunction device, comprising:
- a multifunction controller;
 - a first interface for receiving input data from at least one document data source and a second interface for outputting processed input document data to at least one printer; and
 - a touch screen implementing a graphical user interface for controlling the operation of said multifunction device, including setting operational parameters for said at least one document data source and said at least one printer, and for selecting a mode of operation of said multifunction device;
- wherein said graphical user interface enables a user to **access and search databases that are coupled to said multifunction controller through a global data communications network.**

Thus, language expressly recited in Applicants' claim requires that a user be able to access and search databases that are coupled to the controller through a global data communications network. The accessing and searching must be executable at the graphical user interface.

Applicants understand from the cited portions of Reifman that the Official Action is citing the "library" of Reifman as the "database" of the claims. As an initial matter, Applicants respectfully direct the Examiner's attention to the cited portions of Reifman at col. 62 lines 15-22 which states:

The IFAX 10 supports a **library of cover sheet styles**. Each can be used for different tasks, formal, informal, confidential, personal, corporate, etc. Once created on a Windows Cover

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Page Template Editor, **Cover Sheets can be downloaded to IFAX machines**, transmitted to other intelligent platforms, etc. Each user can maintain a **private** library of cover sheets in addition to the **publicly** available cover sheets on their **system**. [bold emphasis supplied]

As stated above, cover sheets are created on a Windows Editor and downloaded to the IFAX machine. The mere fact that cover sheets need be downloaded to Reifman's IFAX is evidence that cover sheets are not **accessible** nor **searchable** in the convention **database** sense. The words of the claim must be interpreted in light of the specification which discloses standard database access and search features performed on a database which is coupled through a global data communications network and not any sort of local library.

In other instances, Reifman discloses the transmission of cover sheets as data embedded within FAX transmissions or the transfer of CPX files which contain cover sheet data. These transmissions or transfers are always from the point of reference of a user external to the IFAX machine. In other words, the cover sheets must be (in effect) installed on the IFAX in order for the cover sheets to be available on the public or private library on a given IFAX Machine. Applicants assert this also does not constitute **access** and **search** in the conventional **database** manner as required by the claims in light of the Applicants' specification. Note that the word –transmission–, as used in Reifman, consistently refers to facsimile transmission.

In the libraries of Reifman, whether public or private, the cover sheets are stored on the IFAX machine itself. In Reifman, public vs. private is an designation over which cover sheets are visible to a user standing at the IFAX machine. The "public" designation does not imply access over a global network. In support of Applicants'

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assertions, Applicants respectfully direct the Examiner's attention to Reifman at col. 62 lines 30-41 which states:

Install adds cover sheet styles to the **public or private**
library on a given IFAX Machine.

Remove deletes cover sheet styles from an IFAX Machine.

Enclose allows users to **send CPX files** to other users so
that they can share and exchange cover sheet styles.

Print allows users to print a copy of the cover page template
before using.

Preview allows users to see the cover page template on the
LCD [emphasis supplied]

The element by element identity of structure and function necessary for a supportable anticipation rejection are absent from the reference. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of accessing and searching databases that are coupled to the controller through a global data communications network. The accessing and searching must be executable directly at the graphical user interface of the controller.

Even if one were to take to more liberal view that the Reifman patent might be a reference for an obviousness rejection, support necessary for such a rejection is absent from the Official Action and the reference.

For an obviousness rejection, the Examiner would have to apply the analysis of Graham v Deere, 383 US 1 (1966), relying (in this instance) upon a single prior art reference and pointing to a supposed motivation for modifying that single reference. It

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is respectfully submitted that this -- even if attempted by the Examiner -- remains an insufficient ground for rejection.

The Graham v Deere test for obviousness under 35 USC 103 is the subject matter of Section 2141 et seq in the Manual of Patent Examining Procedure. To briefly restate, the three inquiries, in order, are to determine the applicable prior art, then determine the differences between that art and the claimed invention, and then determine whether a person of ordinary skill in the applicable art would know to make the modification necessary to arrive at those differences in view of the prior art applied.

As has been stated by the Court of Appeals for the Federal Circuit in considering matters on appeal from the Board of Appeals within the Patent Office, obviousness is a question of law (the Court citing Graham v Deere), but this determination occurs in the context of a factual inquiry regarding the scope and content of the prior art. This factual inquiry examines what a reference would have taught or suggested to one of ordinary skill in the art at the time the of the invention (the Court citing Northern Telecom v Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321). The Court has cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than the obviousness of the claimed invention as a whole as 35 USC 103 requires (citing Hybritech, Inc. v Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81) and against the use of hindsight reconstruction of what is disclosed in a prior art reference (citing Grain Processing Corp. v American Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788). The Court has quoted approvingly from its decision in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, in which it said:

The mere fact that the prior art may [emphasis added] be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

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On the latter point, the CAFC has said that the Patent Office, in determining the obviousness of a claimed invention that combines known elements, must determine whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination (citing Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Co., 730 F.2d 1452, 221 USPQ 481).

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. See In re Semacker, 702 F.2d 989, 995; 217 USPQ 1, 6 (Fed. Cir. 1983). The reviewing court for the Patent Office requires proof by evidence in order to establish a *prima facie* case when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. See In re Knapp-Monarch Co., 296 F.2d 230, 232; 132 USPQ 6, 8 (CCPA 1961) and In re Cofer, 354 F.2d 664, 668; 148 USPQ 268, 271-272 (CCPA 1966).

No such attempt is made in the Official Action. Indeed, it is Applicants' position that no such attempt can succeed and that recognition of that failing in the prior art has resulted in the absence of any obviousness rejection from the Examiner's argument. It is submitted that this is tantamount to recognition and admission of a patentable invention as defined in the claims under consideration.

For the reasons given above, it is Applicants' position that Claim 5 defines an invention which is patentably distinct from the reference cited, whether applied or not, under the tests of both 35 USC 102 and 35 USC 103. Should the Examiner conclude otherwise, it is respectfully requested that the Examiner's arguments be clarified in any next following Official Action in order that Applicants may more clearly understand the

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element by element identification (if the rejection is under 35 USC 102) and/or the teaching which suggests obviousness of any combination of references (if the rejection is under 35 USC 103).

The 35 USC §103 Rejections

Claims 3 and 4

Claims 3 and 4 stand rejected under 35 USC Section 103(a) over Reifman in view of international application publication WO 97/10668 by Kulakowski et al. (hereinafter "Kulakowski"). In the rejections, the Examiner appears to have embarked on the tests for obviousness as outlined in *Graham v Deere*. Applicants contend these rejections are improper.

Claim 3 has been rewritten in independent form. For the record, although indicated as "currently amended," claim 3 is of original scope and thus has not been amended for any reason related to the statutory requirements for obtaining a patent. Therefore this claim is not subject to the prosecution history estoppel imposed by *Festo*. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1931, 1840, 62 U.S.P.Q.2d 1705, 1712 (2002).

Applicants incorporate herein by reference the above cited law relative to obviousness rejections.

Claim 3

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Here, with respect to Claim 3, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness because the proposed modification would render Reifman unsatisfactory for its intended purpose.

In the background section of Reifman (Col. 1) Reifman presents that original FAX machines were simple and easy to use and that an issue with intelligent FAX (IFAX) machines is that of user training. See, for example, Col. 1, lines 65-68 which states:

Therefore, it can be appreciated that there is a significant need for a system and method of facsimile communication that allows a user to easily interact with the IFAX without extensive training.

Applicants assert that the proposed combination of Reifman and Kulakowski opposes the stated objects of Reifman relative to extensive training. This is so because, in order for a user to set up the email functionality of Kulakowski, the user must set up and be familiar with the email protocols described in Kulakowski at page 15, lines 4-9, including how to obtain parameters for and how to set up incoming POP servers and outgoing SMTP servers and the like and to know the difference. Recall that the IFAX machine of Reifman is a stand alone FAX machine intended to be purchased where standard FAX machines are currently purchased. The inclusion of the email function, for such a store bought machine, requires the type of extensive training shunned in Reifman.

In addition to setting up incoming POP and outgoing SMTP servers and the like, a user attempting to configure the IFAX according to the Examiner's combination would have to procure an internet service contract from an internet service provider ISP. The user would then have to establish and set up the internet connection itself. The establishment of the internet connection can be more challenging than the email set up itself. Additionally, the procedure for establishing an internet connection varies from

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ISP to ISP and therefore, the manufacturer of the proposed IFAX machine could not provide specific instructions to a user on how to establish an internet connection. Conversely, an ISP typically has automatic setup software for simplifying the complex task of establishing and configuring the specific ISP's requirements. Surely, this automatic setup software is intended to run only on a standard PC or Macintosh and not on an IFAX. This leaves the sorting of all of the ISP configuration and setup requirements to the end user. Applicants assert that these extensive internet and email server configuration and set up tasks would require the type of extensive training specifically avoided by Reifman. In combining Reifman with Kulakowski, the Examiner seeks to impliedly design what Reifman has heretofore expressly avoided.

Therefore, Applicants respectfully assert that the Examiner has failed to properly establish a prima facie case of obviousness with respect to claim 3 which has been rejected on the basis of 35 USC 103 because the proposed combination would render Reifman unsatisfactory for its intended purpose of providing an IFAX machine which does not require extensive training such as the level of training assumed in Kulakowski (that of a system administrator or the like). Applicants respectfully request that the rejection be reconsidered and withdrawn in light of the discussion above and believe that claim 3 is in condition for immediate allowance.

Claim 4

With respect to claim 4, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 3 which is believed to be allowable. If an independent claim is nonobvious under 35 U.S.C.103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

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Claims 6-35

Claims 6-35 stand rejected under 35 USC Section 103(a) over U.S. Patent Application Publication US 2001/0013894A1 to Parulski (hereinafter "Parulski") in view Kulakowski cited above. In the rejections, the Examiner appears to have embarked on the tests for obviousness as outlined in *Graham v Deere*. Applicants contend these rejections are improper.

With respect to Claim 6-35, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness because (1) the Examiner's combination is improper, and (2) the combination fails to teach all of the limitations of Applicants' invention as claimed. It is respectfully submitted that each of these two points, as will be explained in further detail hereinafter, is separately capable of standing on its own in defeating the Examiner's *prima facie* case. In addition, the two points can be collectively relied upon for the same purpose.

(1) Examiner's Combination Is Improper

The official Action fails to provide the clear and particular evidence for combining Parulski with Kulakowski as required for a rejection under §103. To establish a *prima facie* case of obviousness, the prior art references when combined must teach or suggest all the recitations of the claim, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. M.P.E.P. §2143. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). To support combining references, evidence of a suggestion, teaching, or motivation to

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combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Court of Appeals for the Federal Circuit has further stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Official Action does not provide any discussion of a motivation, nonetheless particular evidence of a motivation, to combine Parulski with Kulakowski to arrive at the recitations of Claims 6-35. Accordingly, Applicants request withdrawal of the pending rejections of Claims 6-35 and the claims which depend therefrom for at least these reasons.

(2) the Combination Fails to Teach All Limitations of
Applicants' Invention as Claimed

Applicants contend that the Examiner's combination fails to disclose or suggest at least the following bold-highlighted portions of Claim 6, which serves as an example for limitations found in each of claims 6-29:

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6. Apparatus comprising:
- an image capture device which generates a digital record;
 - a printer interface which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;
 - a controller which couples said image capture device and said printer interface, said controller having
 - a touch screen;
 - a first network interface which connects to an area network for bidirectional exchange of digital data; and
 - a second network interface which connects to a second network for bidirectional exchange of digital data; and
 - a control program stored accessibly to and executable on said controller, said control program when executing **implementing a graphical user interface on said touch screen** and enabling a user to select delivery of the digital record to a selected one of said printer interface, said first network interface, and said second network interface.

And likewise, the following bold-highlighted portions of Claim 30, which serves as an example for limitations found in each of claims 30-35:

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30. A method comprising the steps of:
- capturing a digital record of a document;
 - executing on a controller having a touch screen a control program which implements a graphical user interface on said touch screen and which enables a user to select delivery of the captured digital record to one of an associated printer, a first network interface, and a second network interface; and
 - performing in accordance to such selection one of:
 1. delivering the digital record to the printer to generate a copy of the document;
 2. delivering the digital record to the first network interface to generate an electronic mail message;
 3. delivering the digital record to the second network interface to generate a facsimile transmission to a remote facsimile receiver.

Thus, language expressly recited in Applicants' claim requires a touch screen on which a graphical user interface is implemented.

The Examiner cites Parulski Fig. 4 item 303 paragraph 0034 lines 4-8 and offers no other comment. Applicants respectfully traverse this recitation in Parulski as the touchpad of Applicants claim which is capable of implementing a graphical user interface. Rather, item 303 of Parulski is a user control unit which is a separate unit from the display 332 on the same figure. Paragraph 0034 lines 4-10 are included below for convenience and clarity:

... Electronic camera 300 is controlled by user controls 303, such as a series of user buttons including a shutter release

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(e.g., capture button) (not shown) which initiates a picture taking operation. The graphical user interface displayed on color LCD image display 332 is controlled by the user interface portion of the firmware stored in program memory 16

Thus, item 303 is merely a series of buttons. This is incontrovertibly not a touch screen. Nor is the graphical display 332 a touch screen because it is not able to sense touch input.

Further, Applicants assert that neither Parulski nor Kulakowski teaches a touch screen, nonetheless a touch screen capable of implementing a graphical user interface thereon. For example, Kulakowski teaches a keypad 41 (page 12, line 7).

Accordingly, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness with respect to claims 6-35 at least because the references cited fail to teach or suggest all of the limitations of Applicants' invention as claimed. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of implementing a graphical user interface on a touch screen.

Each of points (1) and (2) above is separately capable of standing on its own in defeating the Examiner's *prima facie* case. In addition, the two points can be collectively relied upon, if need be, for the same purpose. Therefore, Applicants believe that claims 6-35 define patentable subject matter and respectfully request that the Examiner remove the Parulski and Kulakowski references as inapplicable to Applicants' novel invention. It is respectfully submitted that pending Claims 6-35 are allowable and further consideration of these claims and their allowance is respectfully requested.

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New Claims

New Claims 36 - 38 are believed to be patentable and not raise new issues which would require a new search and are thus believed to be in condition for immediate allowance because they are not broader than any claim already presented and include limitations which have already been before the examiner.

For example, Claim 36 contains all the limitations of claim 4 which is believed to be in condition for allowance. Claim 37 varies only in scope to claims already prosecuted.

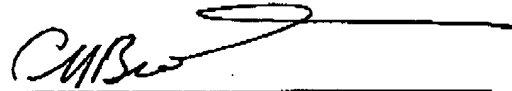
Additionally, claims 36 and 38 contain limitations to the touch screen implementing the graphical user interface wherein the touch screen is "... capable of sensing at most a single touch input ..." Support for this limitation is found in Applicants specification at least in Figure 9D and page 26 lines 13-17. Thus, no new matter has been added. As stated therein, the "@" key is singly provided since most touch screens do not support two inputs, such as simultaneously pressing the "Shift" key and the "2" key in order to encode a "@" character as on a standard QWERTY keyboard.

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Conclusion

In view of the foregoing, it is believed that this case has been placed in condition for a Notice of Allowance and early notice to that effect is earnestly solicited. Should the Examiner wish to have a telephonic discussion of the positions here taken, the courtesy of a telephone call prior to any forthcoming rejection would be greatly appreciated.

Respectfully Submitted,



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